

REMARKS

I. Second Supplemental Information Disclosure Statement

Applicants bring to the Examiner's attention the additional references listed on the attached Information Disclosure Statement Form PTO/SB/08 (1 sheet). Copies of these references are enclosed. It is respectfully requested that the listed references be made of record in the present application.

II. Interview with the Examiner

Applicants thank the Examiner for taking the time to conduct a telephonic interview on September 27, 2004 to clarify certain issues. The claimed invention and the cited references were discussed.

III. Rejections Under 35 U.S.C. § 103(a)

A. Rejections Over Lee and Yue

Independent claims 1, 8, 25, and 31 and dependent claims 2-3, 5-6, 15-16, 26-27, 29-30, 35, and 38-39 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee (U.S. Patent No. 5,504,805) in view of Yue et al. (U.S. Patent No. 5,937,050). Applicants have amended claims 1, 8, 25, and 31 to overcome the cited references and/or to improve their form.

The invention is directed to returning a telephone call in response to a received message. In accordance with the claimed invention, a caller (or calling party) unable to contact a called party stores a message for the called party and the caller's telephone number. The caller is also prompted to provide at least one preference concerning delivery of the message. For example, the caller may specify a preferred time range within which the message is to be delivered. One or more attempts are made to initiate a call to the called party in accordance with the preference, and when the called party is reached, the message is delivered to him/her. Once the message is received, the called party may generate a signal to call back the caller. Upon receipt of the signal, the

caller's telephone number is retrieved from storage and a call is placed to the caller. Once the caller answers, the caller is connected to the called party.

Lee discloses an apparatus that identifies a calling party's telephone number to facilitate a call-back (col. 3, line 44 - col. 4, line 4). Unlike Applicants' invention, Lee does not teach or suggest "initiating" a connection "in accordance with [a] preference" provided by the caller for delivering a message therethrough to a called party, as amended claims 1, 8, 25, and 31 recite. Lee, in fact, makes no mention at all of preferences provided by the caller.

In addition, Lee teaches neither establishing a first connection "through a communication network" to deliver a message, nor establishing a second connection to a telephone number associated with the message and connecting the first connection to the second connection "through the communication network," as also recited in amended claims 1, 8, 25 and 31. By contrast, Lee discloses storing a message in an answering machine apparatus and delivering the message directly from the apparatus to the called party, without traversing any communication network.

Yue discloses a voice mail service which enables a calling party to leave a message for a called party if the called party does not answer (col. 4, lines 7-25). The calling party is given an option to mark the message 'urgent' (col. 24, lines 34-58). After the message is stored, the called party is notified that a message has been received (col. 9, lines 19-37). For example, when the called party turns on his/her mobile phone, a notification call is made to the mobile phone and the called party is informed that new messages are present (col. 21, lines 31 - 46). The called party may then accept the notification call and retrieve his/her messages using a voice mail retrieval menu (col. 21, lines 31-47).

Nowhere does Yue, individually or in combination with Lee, teach or suggest initiating a connection to a called party in accordance with a preference provided by a caller for delivering a message therethrough, as recited by amended claims 1, 8, 25, and 31. As explained to the Examiner in the Interview, Yue, at best, discloses allowing the caller to mark a message as 'urgent' (col. 24, lines 34-58). After a message is

received and stored, a notification call is made to the called party's mobile phone when the mobile phone is turned on (col. 21, lines 31-46), and the called party can then retrieve the message by navigating through the voice mail retrieval menu (col. 21, lines 31-61). However, according to Yue, the message notification call to the called party is "initiated" when the mobile phone is turned on, regardless of whether any message is marked "urgent" by the caller. Similarly, the manner of delivering the message (allowing the called party to use the voice mail retrieval menu) is the same for urgent messages and for non-urgent messages. The fact that a message is or is not marked 'urgent' does not in any way determine how, or when, the notification call to the called party's mobile phone is "initiated." Because Yue, like Lee, fails to teach or suggest initiating a connection, in accordance with a preference provided by a caller, for delivering a message therethrough to a called party, amended claims 1, 8, 25, and 31, together with their dependent claims (2-3, 5-6, 15-16, 26-27, 29-30, 35, and 38-39) are patentable over the cited art.

B. Rejections Over Lee, Yue and Hammond

Dependent claims 4, 14, 28, and 37 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee in view of Yue and in further view of Hammond (U.S. Patent No. 5,155,761).

Claims 4, 14, 28, and 37 depend from claims 1, 8, 25, and 31, respectively, and further claim deriving the caller's telephone number from automatic number identification (ANI).

Hammond discloses a system that automatically calls back the caller if the caller does not reach the desired party. The Examiner stated that the combination of Lee and Yue does not disclose deriving the caller's telephone number from ANI, but that Hammond does disclose using such ANI. Even if Hammond discloses using such ANI, dependent claims 4, 14, 28, and 37 are patentable by virtue of their dependency from amended claims 1, 8, 25 and 31, which are patentable for the reasons stated above.

C. Rejections Over Lee, Yue and Corlett

Dependent claims 7, 9-10, 13, 32-33, and 36 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee in view of Yue and in further view of Corlett et al. (U.S. Patent No. 5,832,060).

Claim 7 recites the apparatus of amended claim 1 comprising a voice response unit. Claims 9 and 32 depend from amended claims 8 and 31, respectively, and further claim that the preference includes a time range within which the message is delivered. Claims 10 and 33 depend from amended claims 8 and 31, respectively, and further claim that the preference includes the number of attempts to deliver the message. Claims 13 and 36 depend from amended claims 8 and 31, respectively, and further claim that the call is unanswered due to a communication problem.

Corlett discloses a system that delivers a message from a caller for a called party, where the system places a call to the called party during intervals predetermined by the system. The Examiner stated that the combination of Lee and Yue does not disclose the specific features claimed in dependent claims 7, 9-10, 13, 32-33, and 36, but that Corlett does disclose such features. Even if Corlett discloses such features, dependent claims 7, 9-10, 13, 32-33, and 36 are patentable by virtue of their dependency from amended claims 1, 8 and 31, which are patentable for the reasons stated above.

D. Rejections Over Lee, Yue and Gray

Dependent claims 11 and 34 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee in view of Yue and in further view of Gray et al. (U.S. Patent No. 5,625,682).

Claims 11 and 34 depend from amended claims 8 and 31, respectively, and further claim that the call is unanswered due to a busy condition.

Gray discloses a help desk arrangement whereby a caller who is not able to access the help desk immediately (because, e.g., all agents are busy) can leave a message with a phone number and a description of the problem. An agent then retrieves the message and calls the caller back.

The Examiner stated that the combination of Lee and Yue does not disclose that the call is unanswered due to a busy condition, but that Gray does disclose this feature. Even if Gray discloses such feature, dependent claims 11 and 34 are patentable by virtue of their dependency from amended claims 8 and 31, which are patentable for the reasons stated above.

E. Rejections Over Gray and Yue

Independent claims 17 and 40, and dependent claims 18 and 41, were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gray et al. in view of Yue. Applicants have amended claims 17 and 40.

As stated above, Gray discloses a help desk arrangement whereby a caller who is not able to access the help desk immediately (because, e.g., all agents are busy) can leave a message with a phone number and a description of the problem. An agent then retrieves the message and calls the caller back.

The Examiner stated that Gray does not disclose an interface for eliciting from the customer at least one preference concerning delivery of the message, but that Yue does disclose this feature.

However, even if Yue discloses this feature, nowhere does Yue disclose initiating a connection to a destination station in accordance with a preference provided by a calling party, as required by amended claims 17 and 40. Accordingly, amended claims 17 and 40, together with their dependent claims (18 and 41, respectively) are patentable over the cited art.

F. Rejections Over Gray, Yue and Lee

Dependent claims 19, 23-24, 42, and 46-47 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gray in view of Yue and in further view of Lee.

Claims 19 and 42 depend from amended claims 17 and 40, respectively, and further claim that the monitored signals indicate a ring-no-answer condition. Claims

23 and 46 depend from amended claims 17 and 40, respectively, and further claim that the telephone number is provided by the caller. Claims 24 and 47 depend from amended claims 17 and 40, respectively, and further claim that the predetermined signal is a DTMF signal.

The Examiner stated that the combination of Gray and Yue does not disclose the specific features claimed in dependent claims 19, 23-24, 42, and 46-47, but that Lee does disclose such features. Even if Lee discloses such features, dependent claims 19, 23-24, 42, and 46-47 are patentable by virtue of their dependency from amended claims 17 and 40, which are patentable for the reasons stated above.

G. Rejections Over Gray, Yue and Corlett

Dependent claims 20 and 43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gray in view of Yue and in further view of Corlett.

Claims 20 and 43 depend from amended claims 17 and 40, respectively, and further claim that the monitored signals indicate a communication problem.

The Examiner stated that the combination of Gray and Yue does not disclose the specific feature claimed in dependent claims 20 and 43, but that Corlett does disclose such features. Even if Corlett discloses such features, dependent claims 20 and 43 are patentable by virtue of their dependency from amended claims 17 and 40, which are patentable for the reasons stated above.

H. Rejections Over Gray, Yue and Hammond

Dependent claims 21-22 and 44-45 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gray in view of Yue and in further view of Hammond.

Claims 21 and 44 depend from amended claims 17 and 40, respectively, and further comprise an operator assisting the customer to obtain information. Claims 22 and 45 depend from amended claims 17 and 40, respectively, and further claim that the caller's number is derived from ANI.

The Examiner stated that the combination of Gray and Yue does not disclose the specific features claimed in dependent claims 21-22 and 44-45, but that Hammond does disclose such features. Even if Hammond discloses such features, dependent claims 21-22 and 44-45 are patentable by virtue of their dependency from amended claims 17 and 40, which are patentable for the reasons stated above.

Conclusion

In view of the foregoing, each of claims 1-47, as amended, is believed to be in condition for allowance. Accordingly, reconsideration of these claims is requested and allowance of the application is earnestly solicited.

Respectfully submitted,

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Enclosures